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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,442	02/15/2002	Partha Neogi	P 0290459 08948-010001	1127

909 7590 10/29/2003  
PILLSBURY WINTHROP, LLP  
P.O. BOX 10500  
MCLEAN, VA 22102

EXAMINER

REYES, HECTOR M

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 10/29/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/075,442

Applicant(s)

NEOGI ET AL.

Examiner

Hector M Reyes

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 August 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 25 to 27, 47, 48, 67, 68, and 72 to 78 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☒ Claim(s) 26, 27, 47, 48, 68, and 73 to 78 is/are allowed.

- 6) ☒ Claim(s) 25 and 72 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Paper Entry**

Examiner acknowledges entry of the following Papers:

- Request for Extension of Time, filed on August 26, 2003 as Paper no. 8 and
- Amendment, filed on August 26, 2003 as Paper no. 9.

### **Status of the Claims**

Claims 1 to 24, 28 and 30 to 46, 49 to 66 and 69 to 71 had been canceled. Claims 25, 26, 27, 47, 48, 67 and 68 had been amended. New claims 72 to 78 had been added. Currently, claims 25 to 27, 47, 48, 67, 68, and 72 to 78 are under Examination.

### **New Rejection Necessitated by Amendment**

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25 and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by:

- Baker et al, CA (chemical Abstract) 126:59751 abstract for WO 9634651 (1997)  
and
- Shono et al CA 112:206735 abstract for JP 01222078 (1990).

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Baker discloses the preparation of analogs of squalene synthetase and protein farnesyl transferase inhibitors. Among the compounds disclosed by Baker is benzenepropanoic acid 4-phenoxy, methyl ester, which has a registry number 185051-02-9.

Shono discloses benzeneacetic acid alpha-methyl-4-phenoxy methyl ester, having a Registry number 126934-95-0.

Claims 25 is also rejected under 35 U.S.C. 102(b) as being anticipated by Tian et al, CA 121:42116 abstract for Zhongguo Huanjing Kexue (1994).

Tian discloses benzene-1-ethyl-4-phenoxy, with a registry number 36207-23-5.

#### ***Allowable Subject Matter***

No pharmaceutical compositions comprising the compounds outlined in claim 25 and 72 and directed to

- Decrease sugar levels in the blood
- Lower the serum triglycerides
- Lower the blood pressure

Were found in the prior art of record.

#### **CONCLUSION**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hector M Reyes whose telephone number is (703) 605-1153. The examiner can normally be reached on M-F 9 to 4 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Rotman can be reached on (703) 308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 or (for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Hector M. Reyes PhD JD*  
*Reg. # P-54846*  
*AU 1625*  
*October 28, 2003*

*Alan L. Rotman*  
ALAN L. ROTMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600